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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,767	08/24/2001	William E. Klunk	076333-0281	8947

22428 7590 01/29/2004

FOLEY AND LARDNER  
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3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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JONES, DAMERON LEVEST

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/935,767	<b>Applicant(s)</b> KLUNK ET AL.	
	<b>Examiner</b> D. L. Jones	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 78-130 is/are pending in the application.  
     4a) Of the above claim(s) 78-83, 85-110, 112, 115, 116 and 125-130 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 84, 111 and 113 is/are rejected.
- 7) ☒ Claim(s) 114 and 117-124 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of the response filed 10/28/03 wherein claims 84, 90, 115, and 117 were amended.

**Note:** Claims 78-130 are pending.

## **RESPONSE TO APPLICANT'S ARGUMENTS**

2. Applicant's arguments with respect to claims 81 and 117-123 have been considered but are moot in view of the new ground(s) of rejection.

**Notes:** Applicant's arguments in regards to examining additional species encompassed by claim 84, as the elected species, have been considered. However, since reexamination of the prior art has resulted in prior art that renders the elected species obvious, a rejection is being made of record. Furthermore, Applicant is reminded that the claims are directed to a genus, not individual species. Therefore, should Applicant overcome the new grounds of rejection the examination will proceed with species encompassed by the genus.

## **APPLICANT'S ELECTED SPECIES**

3. Applicant elected a species encompassed by independent claim 84 having the variables definitions as follows: R3-R7, R9, and R10 = H; Z = S; Y = NR1R2; R1 = H; R8 = OH; and R2 = CH3. *Claims 84, 111, 113, 114, and 117-124 read on the elected species.*

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### **WITHDRAWN CLAIMS**

4. Claims 78-83, 85-110, 112, 115, 116, and 125-130 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention/species.

### **NEW GROUNDS OF REJECTION**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 84, 111, and 113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens et al (US Patent No. 6,034,246).

**Stevens et al** disclose 2-arylbenzazole compounds and pharmaceutically acceptable salts thereof. In particular, Stevens et al disclose Formula I (column 1, line 50 through column 29) wherein R1 and R3 may independently be hydrogen or hydroxyl; X may be S; R2 may be hydrogen; R5 and R6 may independently be hydrogen or alkyl; and R7 may be hydrogen.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Stevens et al and generate Applicant's elected species because when (1) one of R1 or R3 is a hydroxyl located in the R8 position as set forth in Applicant's independent claim 84 (the other of R1 or R3 is

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hydrogen); (2) X = S; (3) both R2 and R7 are hydrogen; and (3) one of R5 or R6 is hydrogen and the other is alkyl, Applicant's elected species is encompassed by Stevens et al.

## CLAIM OBJECTIONS

7. Claims 114 and 117-124 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Note:** The claims are allowable over the prior art of record, but for the elected species ONLY! In particular, the elected species is distinguished over the prior art of record because the prior art does not disclose the elected species encompassed by claim 84 wherein the species binds to an A $\beta$  peptide. In addition, the prior art neither anticipates nor renders obvious the radiolabeling of the elected species.

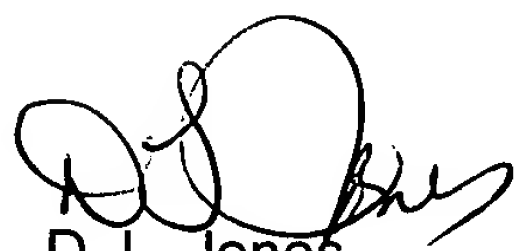
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (703) 308 - 2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



D. L. Jones  
Primary Examiner  
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January 22, 2004